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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,034	04/03/2001	Koichi Hatakeyama	ND-384US	8743

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EXAMINER

ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,034

Applicant(s)

HATAKEYAMA, KOICHI

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 2 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 22, 2005, has been entered.

The amendments to the specification from the After Final Amendment of December 21, 2004, are now entered (and in response, Examiner's objections to the specification are withdrawn).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oakley (Canadian Published Patent Application 2,225,190) in view of official notice. As per claim 1, Oakley discloses an online distribution system, comprising: a search server (page 5, lines 16-30; page 10, lines 7-14); a data distribution server (page 2, line 27, through page 3, line 13); and a download terminal connected to said data distribution

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server (page 5, lines 16-30). Oakley does not expressly disclose a personal terminal, distinct from the download terminal, to which said search server is connectable, but such a terminal is held to be inherent, as necessary to access the Internet Web Site (page 10, lines 7-14). Oakley does not expressly disclose that the download terminal is connected to the search server through the data distribution server, but official notice is taken that it is well known to connect to Internet Web Sites, and thus to the servers on which they are available, through the servers of ISP's, LAN's, WAN's, or other business, etc., servers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the download terminal be connected to the search server through the data distribution server, for the stated advantage of enabling customers' pre-chosen track lists to be recalled, and (after customer confirmation) recorded.

Oakley discloses (by inherency) that said search server includes a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Oakley does not expressly disclose that this search server includes title search means for searching the titles stored in the database, but official notice is taken that it is well known to identify and search for musical and other works by their titles. Oakley's disclosure of recalling pre-chosen track lists at the download terminal implies that subscription and identification information must be stored and transmitted by some means from the search server and/or personal terminal to the download terminal. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the search server include title

search means for searching the titles stored in the database, and subscription information storage means for storing the title searched out by the title search means, for the obvious advantage of enabling customers to identify desired musical works by title.

Oakley discloses a data distribution server including distribution information storage means for storing the distribution information (page 2, line 27, through page 3, line 13). Oakley discloses that the download terminal includes identification information acquisition means for acquiring identification information inputted from the outside (page 10, lines 7-14), first readout means for reading out, based on identification information acquired by said identification information acquisition means, the title stored in said subscription information storage means of said search server which correspond to the identification information (page 10, lines 7-14), second readout means for reading out the distribution information corresponding to the information read out by the first readout means from said distribution information storage means of said data distribution server, and recording means for recording the distribution information read out by said second readout means onto a recording medium (page 10, lines 7-14; page 2, line 23, through page 3, line 2).

Oakley discloses a cache server in which part of the distribution information stored in said distribution information storage means of said data distribution server is stored in advance, and wherein said download terminal acquires, when the distribution information of the title corresponding to the identification information stored in said subscription information means of said search server is stored in said cache server, the

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distributed information from said cache server, but acquires, when the distribution information is not stored in said cache server, the distribution information from said distribution information storage means of said data distribution server (page 3, lines 8-13; page 5, lines 16-30; page 11, lines 21-27).

As per claim 2, Oakley discloses that said download terminal further includes settlement means for performing a settlement in regard to the transmission of the distribution information for said personal terminal (page 2, line 27, through page 3, line 2).

Response to Arguments

Applicant's arguments filed April 22, 2005, have been fully considered but they are not persuasive. Applicant argues that Examiner takes the position that since it is known to connect elements generally by the Internet or other network, any particular connection would thus be obvious. Examiner does not dispute that a novel interconnection of parts which are all individually well known might be novel and non-obvious, but maintains that Applicant has failed to invent and claim such a novel and nonobvious innovation. Further, Applicant fails to present any real argument for why his claimed invention should be considered non-obvious, beyond challenging Examiner's statements regarding inherency and official notice.

Applicant further argues that Examiner's reliance on inherency and official notice are both improper, and writes that an assertion of inherency is only proper where the subject matter regarded as inherent would necessarily follow from subject matter which

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is, in fact, explicitly disclosed. Examiner accepts this standard, and notes that inherency was used as follows: a personal terminal was held to be inherent, as necessary to access the Internet Web Site (page 10, lines 7-14); and it was held to be inherent that the search server included a database for storing a plurality of songs or other works for distribution information (page 10, lines 7-17). Regarding the first, if potential customers access an Internet Web Site, which Oakley discloses, they must have terminals of some sort for doing so, which can be considered personal terminals (although a particular terminal may not necessarily be for the exclusive use of a particular potential customer, which is not a claim limitation). Regarding the second, if potential customers browse and search the repertoire, which Oakley discloses, there would inherently have to be a database for them to browse and search. Applicant does not present any arguments to the contrary, or provide any scenarios by which the features and steps which Oakley discloses could be achieved without the elements which Examiner took to be inherent.

Regarding official notice, Examiner took official notice in rejecting claim 1: first, that it is well known to connect to Internet Web Sites, and thus to the servers on which they are available; and secondly, that it is well known to identify and search for musical and other works by their titles. Neither can be called esoteric technology; both were, in Examiner's judgment, notoriously well known; and both were supported by citations in response to Applicant's challenge. Examiner followed Office policy and standard procedure in including such citations in an Office action to support the takings of official notice without rewriting the rejections to rely explicitly on the newly added citations

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rather than official notice. Thus, claimed subject matter is held to have been obvious to one of ordinary skill in the art at the time of Applicant's invention, and to have been properly rejected.

Conclusion

This is an RCE of applicant's earlier Application No. 09/824,034. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, which **will be changed to 571-273-8300** as of July 15, 2005. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

July 11, 2005